



Image AF/1763

Attorney's Docket No.: 05542-459005 / 5353C2/CMP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Wallace T.Y. Tang
Serial No. : 09/909,766
Filed : July 19, 2001
Title : IN-SITU REAL-TIME MONITORING TECHNIQUE AND APPARATUS FOR
ENDPOINT DETECTION OF THIN FILMS DURING
CHEMICAL/MECHANICAL POLISHING PLANARIZATION

Art Unit : Sylvia MacArthur
Examiner : 1763

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO ACTION OF OCTOBER 8, 2003

In reply to the Office Action of October 8, 2003, the applicant submits the following remarks.

Claims 1-13 and 33-41 are pending. Of these, claims 1, 3 and 33 are independent claims. Claims 1-6, 8, 11-13, 33, 34, and 37 stand rejected under 35 U.S.C. Section 102(e) as being anticipated by U.S. Patent No. 6,537,133 to Birang et al. ("Birang"). Claims 9, 10, 35, and 38-40 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Birang in view of Japanese Patent No. JP 3-234467 to Kokai ("Kokai"). Claims 7, 9, 10, 35, 36, and 38-41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Birang in view of U.S. Patent No 6,589,869 to Sarfaty et al. ("Sarfaty").

The applicant thanks the Examiner for calling and discussing the terminal disclaimer and the cancelled claims 14-32 on September 22, 2003. The applicant has provided below a summary of the substance of the interview.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

December 8, 2003

Date of Deposit

Signature

Carlos A. Brasil

Typed or Printed Name of Person Signing Certificate

SUBSTANCE OF INTERVIEW OF SEPTEMBER 22, 2003

On September 22, 2003, Examiner MacArthur contacted the applicant's representative Tim H. Pham. The Examiner stated that the terminal disclaimer submitted with applicant's response mailed on August 20, 2003 was insufficient because it included the commonly assigned U.S. Patent No. 5,949,927 ("the '927 Patent") but not the co-pending U.S. Patent Application No. 09/134,147 ("the '147 Application"). The applicant's representative explained that there were two terminal disclaimers filed, one filed for the '927 Patent and another for the '147 Application. The participants of the interview agreed that the applicant's representative will fax to the Examiner copies of the terminal disclaimers.

The participants also discussed claims 14-32. The Examiner requested that non-elected claims 14-32 be cancelled. The applicant's representative agreed.

TERMINAL DISCLAIMER

The Examiner stated that, at the time of the office action, the terminal disclaimer of record is insufficient. As indicated above and in the interview of September 22, 2003, there are two terminal disclaimers, one filed for the '927 Patent and another for the '147 Application. Copies of the terminal disclaimers as submitted with the response on August 20, 2003 and as faxed on September 24, 2003 are respectfully enclosed for the Examiner's convenience. The applicant respectfully submits that the enclosed terminal disclaimers are sufficient because one refers to the '927 Patent and the other to the '147 Application.

102 REJECTIONS

Claims 1-6, 8, 11-13, 33, 34, and 37 stand rejected under 35 U.S.C. Section 102(e) as being anticipated by Birang. The applicant respectfully submits that Birang is not prior art. The instant application is a continuation of and claims priority to U.S. Patent No. 07/996,817, filed on December 28, 1992, and issued as U.S. Patent No. 6,614,529. Birang was filed on September 28, 2000. Furthermore, Birang's earliest priority date is March 28, 1995, a date which occurs after the applicant's priority date. Accordingly, Birang is not prior art. For at least this reason, the applicant respectfully submits that claims 1-6, 8, 11-13, 33, 34, and 37 should be allowed.

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103 REJECTIONS

Claims 9, 10, 35, and 38-40 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Birang in view of Kokai. For the reasons discussed above, Birang is not prior art. For at least this reason, the applicant respectfully submits that claims 9, 10, 35, and 38-40 should be allowed.

Claims 7, 9, 10, 35, 36, and 38-41 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Birang in view of Sarfaty. For the reasons discussed above, Birang is not prior art. For at least this reason, the applicant respectfully submits that claims 7, 9, 10, 35, 36, and 38-41 should be allowed. Moreover, Sarfaty is also not prior art. Sarfaty was filed on April 23, 2002. Sarfaty's earliest priority date is December 23, 1999, a date which occurs after the applicant's priority date. Accordingly, Sarfaty is not prior art. For at least this reason, the applicant respectfully submits that claims 7, 9, 10, 35, 36, and 38-41 should be allowed.

No fee is believed due with this response. Please apply any appropriate charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: Dec. 8, 2003



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